

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



Express Mail Label No. EV 105814375 US

In re Application of: TRAVELPRO)
INTERNATIONAL, INC.)

Law Office: 115

10-15-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #58

MARK: FLIGHT CREW)

Examiner: Curtis French

SERIAL NO.: 76/030904)

FILING DATE: April 19, 2000)

BOX TTAB

NO FEE

Assistant Commissioner for Trademarks

2900 Crystal Drive

Arlington, Virginia 22202-3513

APPELLANT'S REPLY BRIEF

I. INTRODUCTION

Applicant hereby replies to the Examining Attorney's Appeal Brief filed September 25, 2002, and respectfully requests that the Trademark Trial and Appeal Board reverse the Examiner's decision refusing registration of the above-identified mark. This Reply Brief is submitted herewith in triplicate.

II. ARGUMENT

A. Examiner's Objection to New Evidence

The Examiner has objected to the Applicant's introduction of USPTO "TESS" and "TARR" records relating to other pending applications and registrations owned by Applicant, namely, Reg. No. 2,393,632 for "CREW3" and Application No. 76/178,624 for "CREW4". They are not "new evidence" in the traditional sense. First, Reg. No. 2,393,632 was actually made of

record by the Examiner as an exhibit to his Final Refusal issued September 25, 2001 and is not "new." *See Exhibit A attached hereto.* Second, both of these records relate to matters in the official records of the USPTO and are not independent records or materials that would require additional review or analysis to verify their authenticity.

These records were introduced by Applicant in response to arguments made by the Examiner in his Rejection of Applicant's Request for Reconsideration. Specifically, the Examiner introduced evidence of a website he mistakenly believed to be owned and operated by Applicant and pointed to allegedly descriptive uses on that website as evidence of purported descriptive uses of the designation "FLIGHT CREW" by the Applicant itself. The records were introduced to demonstrate that: (i) the Applicant does not own or operate the site; and (ii) the operator of the site actually used several registered and pending marks belonging to the Applicant in their trademark capacity – not in a descriptive sense as alleged – which is demonstrated by the operator's reference to several of Applicant's products by their various trademark names. *See Examiner's Rejection of Applicant's Request for Reconsideration (Attachment - VBentley, "Blade Bag Wheel Kit" website).* The records were introduced to make clear that all references to "flight crew" appearing on the website, in fact, refer to Applicant's trademarked goods.

Accordingly, Applicant submits that Reg. No. 2,393,632 for "CREW3" was previously made of the record; and Application No. 76/178,624 for "CREW4" should be considered part of the record as it responds to new arguments and evidence raised by the Examiner in his final rejection.

B. The Term FLIGHT CREW Does Not Identify a Type of Goods

In response to Applicant's Appeal Brief, the Examiner asserts that the designation FLIGHT CREW "is used in the relevant industry to describe a type of small carry-on luggage with wheels and pull handles popularized by FLIGHT CREWS." To support this inference, the Examiner cites to several Internet articles that include the term "flight-crew" in connection with luggage. These are the same references mentioned in the Examining Attorney's office actions and in his Rejection of Applicant's Request for Reconsideration.

As set forth more fully in Applicant's Appeal Brief, the cited references are not persuasive on the issue. First, they are not current references, most date back to 1995 or 1996. In addition, most, if not all, of the references emanate from a 1995 investigation by *Consumer Reports* magazine analyzing luggage products. This is perhaps best demonstrated by the timing of the related articles. *Consumer Reports* published an investigative report on luggage and used the term "flight-crew luggage" to refer to bags with wheels and telescoping handles in December 1995. The articles referenced by the Examining Attorney in his Appeal Brief thereafter appear in the Montreal Gazette on January 16, 1996 and January 20, 1996, the Orange County Register on March 29, 1996, and the Atlanta Journal on June 27, 1996 – all on the heels of the *Consumer Reports* article.

In addition, these articles either acknowledge their origin as being *Consumer Reports* or cross-reference back to the 1995 article:

The Atlanta Constitution article reads – "According to *Consumer Reports* magazine, the following were the better bags."

The Orange County Register article lists *Consumer Reports* as its byline.

The Montreal Gazette states – "(There is also a great rating chart of current flight crew bags in *Consumer Reports*, December 1995)."

The remaining two references cited by the Examiner are to the 1995 *Consumer Reports* article itself. The lack of independent references gives credence to Applicant's argument that *Consumer Reports* adopted the term as an isolated reference that has not been used with any consistency since 1995. Accordingly, the consuming public does not understand the reference to define a type or style of luggage. See *Applicant's Brief, Section 5B*. Moreover, an isolated reference to the term by a consumer magazine almost seven years ago is not sufficient to demonstrate that the consuming public understands the term "flight crew" to refer to a type of style of luggage in the year 2002.

The Examiner's argument fails to account for the fact that trademark terms and language in general are fluid. The meaning assigned to a word may change over time. The fact that a brand name such as "cellophane" may evolve into the generic term for a product bears out this hypothesis. The fact that *Consumer Reports* magazine adopted the term "FLIGHT CREW" to describe a particular type or style of luggage seven years ago is irrelevant where the term did not catch on and develop the required public association between the words and the product to be found descriptive.

Instead, Applicant has demonstrated through affidavits and advertisements by competitors that the commonly used terms that have been adopted and consistently used by the industry and the public for luggage with wheels and telescoping handles are "rolling luggage," and "rolling uprights."

The Examiner next argues that Applicant is somehow at fault for failing to keep *Consumer Reports* and the handful of subsequent publications that picked up on the *Consumer Reports* article from using the term in 1995 and 1996. Clearly, where Applicant's first use of the mark occurred in November 2000, it is illogical that it would have taken any action to stop

Consumer Reports' or any other publication's use of the terminology five years prior to Applicant's own adoption and use. *See Amendment to Allege Use filed August 16, 2002.*

C. FLIGHT CREW is not Used to Identify Intended Users of the Product

The Examiner has argued that the term FLIGHT CREW is used to describe an intended class of user of the product. Applicant does not dispute that all of its products, not just the FLIGHT CREW brand, are purchased by professional flight crew members. However, Applicant submits that the term is used not to describe an intended user, but rather to suggest the extraordinarily high quality and durability of Applicant's goods.

As the Examining Attorney has pointed out, one of Applicant's slogans is "Pilot Designed, Flight Crew Tested". Over the years, Applicant has built its reputation on the high quality and durability of its luggage. The mark FLIGHT CREW, like the foregoing slogan, is intended to communicate the strength and quality of Applicant's luggage by implying that any luggage that can withstand the rigors of the day-in-and-day-out travel of professional flight crew members, is certainly strong enough to withstand the travel needs of the general public. In this regard, Applicant's mark can be likened to the mark "MANICURIST" for use in connection with nail polish which was found suggestive that the product in question would give professional results. *In re Chesebrough-Pond's, Inc.*, 163 U.S.P.Q. 244 (TTAB 1969). The term FLIGHT CREW when applied to Applicant's luggage is suggestive of professional grade or professional quality.

In addition, Applicant wishes to clarify that it has been one of the world's leading luggage companies since at least 1988. Applicant's statement in its specimen to the effect that its luggage is used by over 425,000 professional flight crew members is not specific to, nor limited to, sales of its FLIGHT CREW branded product. Instead, the 425,000 figure includes all styles offered

under its "Pilot Designed, Flight Crew Tested" slogan. Accordingly, it is inappropriate to infer from its hangtag that Applicant has sold 425,000 pieces of its FLIGHT CREW brand luggage to professional flight crew members.

D. Competitor's Do Not Need to Use the Term

The Examiner next argues that allowing Applicant to register the mark FLIGHT CREW would have the effect of precluding Applicant's competitors from describing their luggage as a type of carry-on used by professional travelers, namely, "the same type of luggage used by FLIGHT CREWS." The Examiner's conclusion fails.

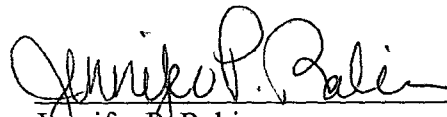
First, Applicant has submitted substantial evidence that third parties and Applicant's competitors are not using the designations "flight crew luggage," "flight crew bags" or "flight crew carry-ons" to refer to luggage with wheels and handles for pulling. Exhibit I to Applicant's Appeal Brief indicates that competitors are using the terms "rolling upright," "upright suiter," "trolley," "rolling carry-on" and "wheeled suiter," among others to refer to such products. There is no evidence of record demonstrating that Applicant's competitors are using the designation FLIGHT CREW in a descriptive or other sense.

Second, the Examiner's conclusion that Applicant's competitors will not be able to indicate that their products are utilized by flight crews if that, in fact, is the case is erroneous. Registration of a trademark does not prevent competitors from using a mark in its truly descriptive sense. 15 U.S.C. §1115(b)(4). Provided that a competitor is using the mark otherwise than as a trademark, fairly and in good faith only for the purpose of describing the fact that flight crew members use their products, the foregoing example presented by the Examiner would be protected from liability.

III. CONCLUSION

On the basis of the foregoing arguments and those set forth in its Appeal Brief, Applicant submits that its mark is not merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act. Accordingly, Applicant's mark is entitled to registration; and the Board is respectfully requested to reverse the Examiner's decision refusing registration.

Respectfully submitted,



Jennifer R. Rabin

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Registration No. 35,667

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Docket No. 6812-219



RECYCLED PAPER



COPY

**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

SERIAL NO. 76/030904		APPLICANT Travelpro International, Inc.		PAPER NO.	
MARK FLIGHT CREW				ADDRESS: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513	
ADDRESS ROBERT J. SACCO AKERMAN, SENTERFITT & EIDSON, P.A. 222 LAKEVIEW AVENUE, SUITE 400 P.O. BOX 3188 WEST PALM BEACH, FLORIDA 33402-3188				ACTION NO. 02	If no fees are enclosed, the address should include the words "Box Responses - No Fee."
				MAILING DATE 09/25/01	
				REF. NO. 6812-219	
FORM PTO-1525 (5-90)		U.S. DEPT. OF COMM. PAT. & TM OFFICE		Please provide in all correspondence: 1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.	

FINAL

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 76/030904

This letter responds to the applicant's communication filed on April 9, 2001.

Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), because the subject matter for which registration is sought is merely descriptive of the identified goods.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal under Section 2(e)(1) is maintained and made FINAL.

DESCRIPTIVENESS

The examining attorney refuses registration on the Principal Register because the proposed mark merely describes the goods. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); TMEP section 1209 *et seq.*

DOCKETED

FLIGHT CREW Descriptive

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b). It is not necessary that a term describe all of the purposes, functions, characteristics or features of the goods to be merely descriptive. It is enough if the term describes one attribute of the goods. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAAssociates*, 180 USPQ 338 (TTAB 1973).

The applicant has applied to register the mark FLIGHT CREW for luggage. The term FLIGHT CREW is used in the travel industry to describe a specific type of bag or suitcase, namely, a small, soft-sided suitcase with built-in wheels and a long handle for pulling. *Please see Office Action dated October 6, 2000 for articles evidencing the descriptive nature of the term FLIGHT CREW.*

The term FLIGHT CREW is merely descriptive of the applicant's goods, namely, compact luggage with long handles and wheels, popularized by FLIGHT CREWS, which have become known in the relevant industry as FLIGHT CREW bags or cases. The mark immediately names the exact nature of the goods and does nothing else. Accordingly, the mark is refused registration on the Principal Register under Section 2 (e) (1).

The applicant disputes that the term FLIGHT CREW is primarily merely descriptive because the applicant claims that it was the first company to design and market luggage with long handles and wheels. *Please see applicant's response dated April 9, 2001.* The applicant claims many consumers now identify FLIGHT CREW as a brand of luggage and distributed by the applicant. The applicant's response is void of any evidence to support its argument. Additionally, the fact that an applicant *may* be the first user of a merely descriptive or generic designation does not justify registration if the term is merely descriptive. *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983).

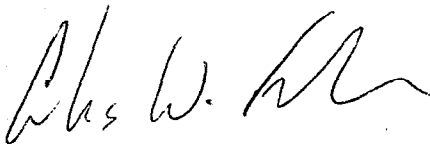
The applicant lists a couple of registered marks to support its argument that it has marketed and sold luggage using the term FLIGHT CREW. The Office does not consider mere listings (rather than copies) of prior registrations. *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974). However, the examining attorney notes that the two cited registrations are not similar to the mark in this case. *The examining attorney has attached copies of the relevant registrations with this Action.* In Registration No. 1927128, the registrant disclaimed the descriptive wording from the mark, namely, FLIGHT CREW TESTED. Registration No. 2393632 was registered because the arbitrary mark CREW3 is not descriptive in relation to the goods. The examining attorney must consider each case on its own merits. A mark which is merely descriptive is not registrable merely because other similar marks appear on the register. *In re Scholastic Testing Services, Inc.*, 196 USPQ 517 (TTAB 1977). In this case, the marks cited by the applicant are not similar to the present mark, and any terms similar to the applicant's terms were disclaimed as descriptive.

In the present case, imagination, thought or perception is not required to determine the nature of the goods from the term. The applicant's goods are compact luggage with long handles and wheels, popularized by FLIGHT CREWS, which have become known in the relevant industry as FLIGHT CREW bags or cases.

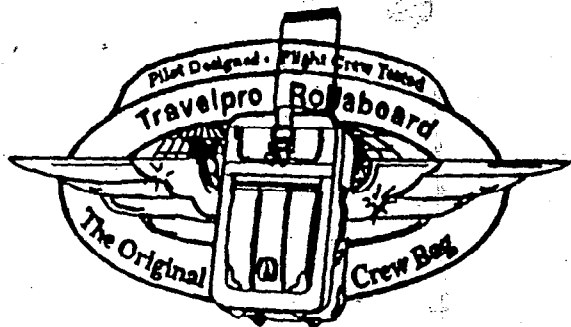
In view of all of the foregoing, the refusal pursuant to Trademark Act Section 2(e)(1) is repeated and made FINAL

RESPONSE

Please note that the only appropriate responses to a final action are either (1) compliance with the outstanding requirements, if feasible, or (2) filing of an appeal to the Trademark Trial and Appeal Board. 37 C.F.R. Section 2.64(a). If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. Section 2.65(a).



Curtis W. French
Trademark Attorney
Law Office 115
703-308-9115 ext. 250



Mark

TRAVELPRO ROLLABOARD THE ORIGINAL CREW BAG PILOT DESIGNED - FLIGHT CREW TESTED

Goods and Services

IC 018. US 002 003. G & S: luggage and attache cases. FIRST USE: 19931210. FIRST USE IN COMMERCE: 19931210

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

010701 010704 031701 190101 260317

Serial Number

74491254

Filing Date

February 17, 1994

Publication for Opposition Date

July 25, 1995

Registration Number

1927128

Registration Date

October 17, 1995

Owner Name and Address

(REGISTRANT) Eiffel Design, Inc. CORPORATION FLORIDA 501 Fairway Drive
Deerfield Beach FLORIDA 33441

(LAST LISTED OWNER) TRAVELPRO INTERNATIONAL, INC. CORPORATION BY MERGER
DELAWARE 100 BANYAN COURT BOCA RATON FLORIDA 33431

Assignment Recorded

ASSIGNMENT RECORDED

Prior Registration(s)

1587822;1706770

Disclaimer Statement

*** User: cfrench *** Serial Number: 74491254 ***

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PILOT DESIGNED", "FLIGHT CREW TESTED", "THE ORIGINAL" and "BAG" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit Text
SECT 15. SECT 8 (6-YR).

Live Dead Indicator
LIVE

Attorney of Record
ROBERT J. SACCO

CREW3

Mark

CREW3

Pseudo Mark

CREW 3

Goods and Services

IC 018. US 001 002 003 022 041. G & S: luggage, bags and carrying cases. FIRST USE: 19990200. FIRST USE IN COMMERCE: 19990200

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75856959

Filing Date

November 23, 1999

Publication for Opposition Date

July 18, 2000

Registration Number

2393632

Registration Date

October 10, 2000

Owner Name and Address

(REGISTRANT) Travelpro International, Inc. CORPORATION DELAWARE 700
Banyan Trail Boca Raton FLORIDA 33431

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

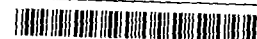
LIVE

Attorney of Record

Robert J. Sacco

THA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD



Express Mail Label No. EV 105814375 US

10-15-2002

In re Application of: TRAVELPRO
INTERNATIONAL, INC.

) Law Office 115

U.S. Patent & TMO/TM Mail Rcpt Dt. #58

MARK: FLIGHT CREW

) Examiner: Curtis French

SERIAL NO.: 76/030904

FILING DATE: April 19, 2000

TRANSMITTAL LETTER

Box TTAB - NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

02 OCT 22 AM 12:36

TRADEMARK TRIAL AND
APPEAL BOARD

Sir:

X Appellant's Reply Brief, with Exhibit A, in triplicate

X Two (2) postcards

This transmittal letter is submitted in duplicate. Please charge any deficiency or credit any excess in fee payment to Deposit Account No. 50-0951.

Respectfully submitted,

Date: October 15, 2002

Jennifer P. Rabin
Robert J. Sacco
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Our Ref. No.: 6812-219

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Express Mail Label No. EV 105814375 US

In re Application of: TRAVELPRO
INTERNATIONAL, INC.

) Law Office 115
)
)

) Examiner: Curtis French
)
)

MARK: FLIGHT CREW
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SERIAL NO.: 76/030904
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TRANSMITTAL LETTER

Box TTAB - NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

X Appellant's Reply Brief, with Exhibit A, in triplicate

X Two (2) postcards

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Respectfully submitted,

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Our Ref. No.: 6812-219